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Ole Olsen

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EXAMINER

KURTZ, BENJAMIN M

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1797

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,346	Applicant(s) OLSEN ET AL.	
	Examiner BENJAMIN KURTZ	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 102-130 is/are pending in the application.
- 4a) Of the above claim(s) 126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 102-125 and 127-130 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/06, 7/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 102-125 and 127-130, drawn to a filter and a filter housing.

Group II, claim(s) 126, drawn to a method of producing a filter.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of group I is that the filter comprises at least two layers of filtration medium and the special technical feature of group II is that the filter is made from at least one layer of filtration medium.

2. During a telephone conversation with Ronald Citkowski on 10/21/08 a provisional election was made without traverse to prosecute the invention of Group I, claims 102-125 and 127-130. Affirmation of this election must be made by applicant in replying to this Office action. Claim 126 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

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patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 103-108, 110, 111, 114, 115, 119-121 and 127-130 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 103 recites the limitation "said sealed at least one inner layer of filtration medium" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim. For examination purposes the at least one inner layer of filtration medium is assumed to be sealed.

Claims 104, 110, 111, 115 and 119 are rejected as depending from claim 103.

Claim 105 recites the limitation "said at least one layer of spacer medium" and "said at least one layer of filtration medium". There is insufficient antecedent basis for this limitation in the claim. For examination purposes claim 105 is assumed to depend from claim 104 and the at least one layer of filtration medium is assumed to be said at least two layers of filtration medium.

Claim 106 is rejected as depending from claim 105.

Claim 107 recites the limitation "said spacer medium". There is insufficient antecedent basis for this limitation in the claim. For examination purposes the additional sealing is assumed to seal an edge of filtration medium.

Claim 108 recites the limitation "said sealings" and "said spacer medium". There is insufficient antecedent basis for this limitation in the claim. For examination purposes there are assumed to be at least two sealings and there is assumed to be no spacer medium.

Claim 114 recites the limitation "said cellulose fibres". There is insufficient antecedent basis for this limitation in the claim. For examination purposes claim 114 is assumed to depend from claim 113.

Claim 120 recites the limitation "said spacer medium". There is insufficient antecedent basis for this limitation in the claim. For examination purposes there is assumed to be no spacer medium recited.

Claim 121 recites the limitation "said inner zone". There is insufficient antecedent basis for this limitation in the claim. For examination purposes the filter medium is assumed to have an inner zone.

Claim 127 provides for the use of a filter according to claim 102, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 127-130 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 102-113, 115, 116, 118-122 and 125 are rejected under 35 U.S.C. 102(b) as being anticipated by Hunter et al. US 2 537 898.

Claim 102, Hunter teaches a filter, the filter comprises: at least two layers of filtration medium wherein the two layer of filtration medium comprise: at least one inner layer (S) of filtration medium and at least one outer layer (P) of filtration medium and wherein the outer layer is positioned outside the inner layer in respect of a horizontal direction of fluid to be filtered, and wherein a first sealing (12) is positioned outside of the inner layer of filtration medium and inside of the outer layer of filtration medium, and

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wherein the filtration mediums and sealing are arranged to allow fluid to enter the outer layer of filtration medium and flow through the inner layer of filtration medium (fig. 1).

Claims 103-113, 115, 116 and 118-121, Hunter further teaches the inner layer of filtration medium and the outer layer of filtration medium each have a filtration area and at least one edge, the at least one edge being located at the area of the first sealing, and wherein the first sealing comprises a sealing prohibiting fluid to enter the at least one edge of the inner layer of filtration medium which is sealed (fig. 1); the filter comprises at least one layer of spacer medium (the creped cellulose sheets), the at least one layer of spacer medium has at least one edge and a spacer area, and wherein the at least one layer of spacer medium is provided between the inner layer of filtration medium next to the filtration area of the filtration medium (fig. 1, col. 1, lines 39-42); the filtration medium alternate with the spacer medium (fig. 1); the innermost layer of the filter is at least one layer of the at least one inner layer of filtration medium (fig. 1); an additional sealing (7) with distance to the first sealing, the additional sealing seals an edge of the filtration medium and the edges of filtration medium between each sealing are unsealed (fig. 1); the sealing comprises an end cap (4) the end cap provides open spaces (11) comprising bypass spaces between sealings (12) (7) (fig. 1); the end cap further comprises perforations (10) in the end cap itself in the area outside of the first sealing (fig. 1); the filtration medium and the spacer medium have pores and the pores of the spacer medium are larger than the pores of the filtration medium (col. 1, lines 48-49); the pores are smaller in the inner layers of the filtration medium than in the outer layers of the filtration medium (col. 1, lines 51-53); the filtration medium is sheets of

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cellulose (fig. 1); the spacer medium is cellulose (fig. 1); the filter comprises at least one perforated core (2) (fig. 1); the core comprises apertures (3) (fig. 1); the filtration medium and the at least one spacer medium are overlying one another and spirally surrounding the central core (fig. 1, col. 1, lines 39-42); the filtration medium forms an inner zone adjacent to the core, comprising at least one round of filtration medium (fig. 1); and the end cap is closed in the area of the inner zone and perforated in the area outside of the inner zone (fig. 1).

Claim 122, Hunter teaches a filter house comprising at least one filter cartridge with a filter, the filter comprising: at least two layers of filtration medium wherein the two layer of filtration medium comprise: at least one inner layer (S) of filtration medium and at least one outer layer (P) of filtration medium and wherein the outer layer is positioned outside the inner layer in respect of a horizontal direction of fluid to be filtered, and wherein a first sealing (12) is positioned outside of the inner layer of filtration medium and inside of the outer layer of filtration medium, and wherein the filtration mediums and sealing are arranged to allow fluid to enter the outer layer of filtration medium and flow through the inner layer of filtration medium (fig. 1, col. 2, lines 20-23).

Claim 125, Hunter further teaches the filter house comprises at least one entry and at least one exit (col. 2, lines 20-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 117 and 123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter '898.

Claim 117, Hunter teaches the filter of claim 116 but does not teach what material the core is made of. Cores made of polymer and metal are very well known in the art and would have been an obvious choice to one of ordinary skill in the art because of the strength and durability of metal and polymer products.

Claim 123, Hunter teaches the filter house of claim 122 but does not teach two filter cartridges. Providing two filter cartridges in a housing is known in the filter art to increase capacity and surface area of a filter apparatus and the addition of a second filter cartridge is a mere duplication of parts. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *In re Harza*, 124 USPQ 378 (1960).

8. Claim 114 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter '898 in view of Novak US 5 744 406.

Hunter teaches the filter of claim 113 but does not teach the cellulose fibers are made hydrophobic. Novak teaches making cellulose fabrics hydrophobic by treating

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them with waxes (col. 3, lines 11-21). The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art, KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (2007). It also would have been obvious because making the filter hydrophobic allows the filter to absorb oily substances.

9. Claim 124 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter '898 in view of Boogay US 4 299 699.

Hunter teaches the filter house of claim 122 but does not teach the filter house comprises a container with an opening means. Boogay teaches a filter house comprising a container and the container has at least one opening means (25) through which the filter cartridge may be changed (fig. 1). Having the housing with an opening for replacement of the filter cartridge is very well known in the filter art. The claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN KURTZ whose telephone number is

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(571)272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin Kurtz
Examiner
Art Unit 1797

/Benjamin Kurtz/
Examiner, Art Unit 1797
10/22/08

/Krishnan S Menon/
Primary Examiner, Art Unit 1797